

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

N. Parker Willis, et al.

Serial No.: 09/128,304

Filed: August 3, 1998

For: DYNAMICALLY ALTERABLE
THREE-DIMENSIONAL GRAPHICAL
MODEL OF A BODY REGION



Group Art Unit: 3737

Examiner: Eleni Mantis Mercader

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TECHNOLOGY CENTER R3700

PETITION UNDER 37 C.F.R. 1.181 (a)
TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE
TO RECEIVE OFFICE ACTION MAILED OCTOBER 23, 2001

Box: DAC
Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby petitions to withdraw the abandonment of the above-identified application, based on the following:

1. On June 10, 2002, Lyon & Lyon LLP received a Notice of Abandonment mailed June 4, 2002, which states that the abandonment of the application is due to *"Applicant's failure to timely reply to Office letter mailed on 23 October 2001."* See Exhibit A.

2. However, the referred Office Action of October 23, 2001, was never received by Lyon & Lyon LLP prior to receiving the Notice of Abandonment.

07/30/2002 AMONDAF1 00000006 09128304

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3. On October 15, 2001, the above identified application was physically transferred from Stallman & Pollock LLP to Lyon & Lyon LLP at the instructions and authorization of the assignee Cardiac Pathways Corporation. Although the application file was physically transferred on October 15, 2001, the attorneys of records for this application on October 23, 2001 were still Stallman & Pollock LLP. Therefore, the Patent Office should have mailed the Office Action to the Stallman & Pollock LLP correspondence address of record.

4. Enclosed herewith in support of this petition is a Declaration of Kathleen Frost, partner of Stallman & Pollock LLP executed on July 12, 2002, which states: "Although we transferred the file for this application and other Cardiac Pathways files to Lyon & Lyon, LLP on October 15, 2001, I continue to review any mail received by our firm in connection with Cardiac Pathways matters and to forward any such mail to Lyon & Lyon, LLP. I have reviewed our correspondence files for Cardiac Pathways matters and have determined *that no Office Action dated October 23, 2001 was ever received by Stallman & Pollock, L.L.P.*". See Exhibit B

5. Moreover, I personally reviewed the file jacket and the docketing entries in the electronic docketing system of Lyon & Lyon LLP pertaining to above-identified application, which indicated that no Office Action had been received, between October 23, 2001 through June 4, 2002. I was unable to locate any evidence of an Office Action. If such a document had been received by Lyon & Lyon either from the Patent Office or from Stallman & Pollock, LLP, it would have been docketed in our electronic docketing system, and the original copy would be in the file jacket.

6. Attached, as Exhibit "C" is true and correct copy of the Lyon & Lyon LLP docket page for the above-identified application, with no record of ever receiving the Office Action mailed on October 23, 2001.

7. Attached as Exhibit "D" is a true and correct copy of the Lyon & Lyon LLP "reminder list" report from October 23, 2001 to June 4, 2002, generated by our docket system for all Cardiac Pathways Corporation applications, which shows due dates and actions due during this period. If we had received the Office Action dated October 23, 2001, it would have been docketed and it would appear in the attached list. However, there is no reminder to respond to an Office Action for this application with mailing date of October 23, 2001.

8. Upon receipt and review of the papers attached as Exhibit A, the undersigned attorney requested Maritza Kidd, who is a patent paralegal, to telephone the Examiner regarding the abandonment of this application. The Examiner sent Ms. Kidd a copy of the "last office action" via fax on June 18, 2002, (enclosed as Exhibit E). However:

- A. The faxed papers did not include the front page showing the mailing date of the Office Action.
- B. The papers did not include the Examiner's signature.
- C. In any event, by the time the papers in Exhibit E were received by the undersigned, the application was already abandoned by the Patent Office.

9. It is known that anthrax-related decontamination activities caused delivery problems with the United States Postal Services in October and November of 2001. Since the Office Action was mailed on October 23, 2001, it is possible that the office action was lost in the mail.

10. Based on the foregoing circumstances, Applicant requests withdrawal of abandonment of the Application for failure to receive Office Action dated October 23, 2002. Please kindly restate time for mailing the referred **Office Action** in response to amendment filed on August 3, 2001.

11. No Terminal Disclaimer is required because the application was filed after June 8, 1995 and it is a utility patent application.

12. Enclosed herewith is the petition fee under rule 37 CFR 1.17(h) of the current fee schedule of \$130.00. The Commissioner is authorized to charge or credit any underpayment or overpayment associated with this petition to the Deposit Account No: 12-2475.

Respectfully submitted,

LYON & LYON LLP

Dated: July 23, 2002

By: DT Burse
David T. Burse
Reg. No. 37,104

Please send all correspondence and direct all inquiries to David T. Burse, current attorney of records at Customer Number:



22249

PATENT TRADEMARK OFFICE

LYON & LYON LLP
Suite 4700
633 W. Fifth Street
Los Angeles, CA 90071
(213) 489-1600

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/128,304	08/03/1998	N. PARKER WILLIS	CRDP-2700	2536

22249 7590 06/04/2002

LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES, CA 90071



271/054

EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT PAPER NUMBER

3737

DATE MAILED: 06/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

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U.S. PROSECUTION



Notice of Abandonment

Application No.	Applicant(s)	
09/128,304	WILLIS ET AL.	
Examiner	Art Unit	
Eleni Mantis Mercader	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 23 October 2001.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

N. Parker Willis, et al.

Serial No.: 09/128,304

Filed: August 3, 1998

For: DYNAMICALLY ALTERABLE THREE-
DIMENSIONAL GRAPHICAL MODEL OF
A BODY REGION



Group Art Unit: 3737

Examiner: Eleni Mantis Mercader

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**DECLARATION OF KATHLEEN FROST IN SUPPORT OF
PETITION UNDER 37 C.F.R. 1.181 (a)**

BOX DAC

Commissioner for Patents
Washington, D.C. 20231

Sir:

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I, Kathleen Frost, declare:

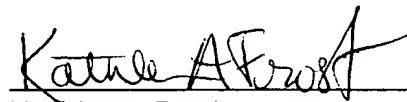
1. I am a partner in the law firm of Stallman & Pollock, LLP and was the original Attorney of Record in this Application, Registration No. 37,326.
2. The above-identified application was filed on August 3, 1998.
3. On October 15, 2001, our file for the above-identified application (as well as our files for other matters for our then-client Cardiac Pathways Corporation) was transferred to Lyon & Lyon, LLP. At that time (10/15/01), the last action shown in the file for this application was an Amendment and IDS

submitted by Stallman & Pollock, LLP to the U.S. Patent and Trademark Office (USPTO) on July 30, 2001.

4. I have not received any Office Action mailed October 23, 2001 in connection with the identified application.

5. Although we transferred the file for this application and other Cardiac Pathways files to Lyon & Lyon, LLP on October 15, 2001, I continue to review any mail received by our firm in connection with Cardiac Pathways matters and to forward any such mail to Lyon & Lyon, LLP. I have reviewed our remaining correspondence files for Cardiac Pathways matters and have determined that no Office Action dated October 23, 2001 was ever received by Stallman & Pollock, LLP in connection with the identified matter.

Executed this 12th day of July, 2002.


Kathleen Frost
Reg. No. 37,326

STALLMAN & POLLOCK LLP
121 Spear Street, Suite 290
San Francisco, CA 94105
(415) 512.1312

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OPER WM ENTERED 5/9/2002 MODIFIED 10/2002 ATTORNEYS DTB / MJB / N/A PRINTED ON: 7/11/2002
LL# 271/054US CNTRY US UNITED STATES NEW/CON NEW RELATED
PATS# P14271US0 TYPE UTL SERIAL# 09/128,304 PATENT# STAT PENDING
TITLE DYNAMICALLY ALTERABLE THREE-DIMENSIONAL GRAPHICAL MODEL OF A BODY REGION SBST
CLIENT CAPC CARDIAC PATHWAYS CORPORATION 1 CREF SE SBDT
(BOSTON SCIENTIFIC)
AGENT AREF CLAIMS PUBL#
PRIOR 8/3/1998 MAIL 8/3/1998 FILE 8/3/1998 PUBL ISSUE EXP 8/3/2018 1ST 8/3/1998

ID	O	ACTION	BASE	DUE IN	DUE	EXTNS	FINAL	EXT	RESPONSE	CALL	1	2	P
F9	N	TAXES PD BY CLIENT	5/9/2002	0M	5/9/2002		5/9/2002	0		0M	Y	Y	Y
MK	Y	INCOMING MAIL (ATTY)	6/4/2002										
NOTICE OF ABANDONMENT REC'D 6/10/02													
DD	N	DUE DILIGENCE DATE	5/9/2002	2M	7/9/2002		7/9/2002	0		0M	Y	Y	Y

INVENTORS

WILLIS N PARKER et al

ZENFG JINGLIN

QUARATO JAMES A

"C"

NOTES

TAKEN OVER FOR PROSECUTION 01/11/02

ACTIONS DUE BETWEEN 10/23/2001 AND 6/4/2002

Printed: 7/18/2002

Page 1

REFERENCE#	MARK/TITLE	ACTION	BASE DT	DUE DT	FINAL	RESPONSE	ATTY1 / ATTY2
270/232US	CATHETER INCLUDING UTRASOU	TAXES PD BY CLIENT	5/9/2002	5/9/2002	5/9/2002		DTB / N/A / N/A
268/298US	SYSTEM FOR ELECTRODE LOCAL	TAXES PD BY CLIENT	5/9/2002	5/9/2002	5/9/2002		DTB / MJB / N/A
269/212US	CENTER SUPPORT FOR STEERAB	TAXES PD BY CLIENT	5/9/2002	5/9/2002	5/9/2002		DTB / N/A / N/A
271/054US	DYNAMICALLY ALTERABLE THRE	TAXES PD BY CLIENT	5/9/2002	5/9/2002	5/9/2002		DTB / MJB / N/A
END OF REPOR						TOTAL ITEMS SELECTED =	4

E"

Attn: Lyon & Lyon
Ms. Maritza Kidd

From: Ex. Maritza Mercader

As per your request please find a copy
of last office action.

Abandonment was mailed out on 6/4/2002

Office Action Summary

Application No.

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Applicant(s)

09/128,304

WILLIS ET AL.

Examiner

Art Unit

Eleni Mantis Mercader

3737

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If the period for reply specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

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Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

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Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

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Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

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Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Application/Control Number: 09/128,304
Art Unit: 3737

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DETAILED ACTION

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Response to Arguments

2. Applicant's arguments with respect to claims 1-60 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(e) of this title before the invention thereof by the applicant for patent.

4. Claims 1-60 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Budd et al. '108, of record.

Budd et al. '108 teach all the features of the instant invention including a deforming model as illustrated in Figure 7, see col. 7, lines 15-55.

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Art Unit: 3737

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Wed. - Wed., 7:00 a.m.-5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-7635. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-0758 for regular communications and 703 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.